

Office Action Summary	Application No. 09/078,555	Applicant(s) PATEL ET AL.	
	Examiner CONGVAN TRAN	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 24,25,28,29,31-33,35,36 and 38-41 is/are pending in the application.
- 5a) Of the above claim(s) 1-23,26,27,30,34 and 37 is/are withdrawn from consideration.
- 6) ☒ Claim(s) 24,25,31-33 and 38-41 is/are allowed.
- 7) ☒ Claim(s) 28,29,35 and 36 is/are rejected.
- 8) ☐ Claim(s) _____ is/are objected to.
- 9) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/078,555

05/14/1998

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Q50373

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EXAMINER

TRAN, CONGVAN

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

09/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. Upon further consideration of the Interference request and in light of the recent US CAFC decision "Agilent Technologies Inc. V. Affymetrix Inc., 567 F.3d 1366 (Fed. Cir. 2009)" and the subsequent change to 37 CFR 41.200 (see Federal Register notice vol. 75, No. 72, 4/15/10, pg. 19558), the indicated allowability of claims 28-29 and 35-36 are withdrawn and the following action is presented.

When considering the Interference request with respect to claim 14 of the patent and claim 35 of the application, the originating disclosure of the patent is reviewed to provide the meaning of the pertinent claim language. Applicants means plus function limitations when read in light of the specification to provide meaning and structure to the pertinent claim language are not the same as the limitations in the patent. Note for claim 14 in the patent, the limitation "means for determining the variation of the DC level..." includes the structural elements 36 memory and 38 DC offset in Figure 1 where as in claim 35 of application, the limitation "means for determining the DC level..." includes the structural element of 38 a pilot detector in Figure 1. Furthermore claim 14 is detecting a variation of the DC level in order to control the operating mode whereas claim 35 is detecting the level itself in order to control the operating mode. Also note in claim 14 the limitation "means for controlling" in the patent refers to a comparator 41 (figure 1) whereas the means for controlling in application claim 35 refers to a data sync selector 46 (figure 2). Clearly applicant and patentee are not claiming the same invention. Therefor an interference cannot be declared between the claims of the patent and this application.

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2. Prosecution on the merits of this application is reopened on claims 28-29 and 35-36 considered unpatentable for the reasons indicated below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 28-29 and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The subject matters which were not supported in the original specification:

“processing the filed synchronizing signal to determine the variation of the DC offset in the received signal” in claim 28;

Claim 29 is rejected as being dependent on independent claim 28.

“of the determined DC variation” in claim 35; and

“said DC variation means” in claim 36.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "of the determined DC variation" in lines 5-6.

There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "said DC variation means" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

7. Claims 24-25, 31-33 38-41 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CongVan Tran whose telephone number is (571)272-7871. The examiner can normally be reached on monday-thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Appiah Charles can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/CongVan Tran/

Primary Examiner, Art Unit 2617